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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,793	08/17/2001	Chew Kai Hwa	1085-029/ddh	5435
21034	7590	06/15/2004	EXAMINER	
IPSOLON LLP 805 SW BROADWAY, #2740 PORTLAND, OR 97205			IP, SIKYIN	
			ART UNIT	PAPER NUMBER

1742

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

**Office Action Summary**

Application No.

09/932,793

Applicant(s)

HWA ET AL.

Examiner

Sikyin Ip

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/5/04;3/18/04.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-6,9-11,14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-6,9-11,14,15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4, 6, and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The limitation "Young's Modulus of no more than about 9512 MPa" in said claims are new matter. In instant Figure 7 discloses only one data point, 9512.28 MPa, which does not support the whole range.

### **Claim Rejections - 35 USC § 103**

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 6, and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 9709455 (abstract, alloys c and f-h), USP 5538686 to Chen et al (col. 1, line 60 to col. 2, line 37), JP 10314980 (abstract), JP 2000141078 (abstract), WO 2000018536 (abstract), or JP 11221694 (abstract).

The cited reference(s) disclose(s) the features including the claimed Pb-free Sn based solder. The difference between the reference(s) and the claims are as follows: Cited references' solder alloys do not disclose P element. But, P element content "no more than 0.01" in instant claims 1, 6, and 11 reads on zero which suggests said P element could be eliminated from the claimed solder alloy. When prior art compounds essentially "bracketing" the claimed compounds in structural similarity are all known, one of ordinary skill in the art would clearly be motivated to make those claimed compounds in searching for new products in the expectation that compounds similar in structure will have similar properties. In re Gyurik, 596 F.2d 1012, 1018, 201 USPQ 552, 557 (CCPA 1979); See In re May, 574 F.2d 1082, 1094, 197 USPQ 601, 611 (CCPA 1978) and In re Hoch, 57 CCPA 1292, 1296, 428 F.2d 1341, 1344, 166 USPQ 406, 409 (1970). Therefore, it would have been obvious to one of ordinary skill in the art to select

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any portion of range, including the claimed range, from the broader range disclosed in a prior art reference because the prior art reference finds that the prior art composition in the entire disclosed range has a suitable utility. Also see MPEP § 2131.03 and § 2123.

The phrase "for use in wave soldering" is an intended use which does not lend patentability to the alloy and/or the process. Reciting the contemplated end-use in a product claim directed to an old compound does not impart thereto the novelty requisite to patentability, even though the end-use is unobvious. In re Thuau 135 F2d 344, 57 USPQ 324 (CCPA 1943). Moreover, as is evinced by WO 9709455 that solders of cited references are interchangeable for hand soldering, wave soldering, or paste reflow soldering (see abstract in the "ADVANTAGE" paragraph.)

Claims 4, 5, 9, 10, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over references as applied to claims 1, 6, and 11 above, and further in view of JP 2001058286 (abstract).

The claimed subject matter as is disclosed and rejected above by the cited reference(s) except for P element. However, JP 2001058286 in the abstract teaches P content less or equal to 0.2 wt.% could be added as antioxidant element in the same field of endeavor or the analogous metallurgical art. Therefore, it would have been obvious to one having ordinary skill in the art of the cited references at the time the invention was made to provide Sn base solder with P element as taught by JP 2001058286 in order to improve antioxidant. It has been held that combining known

ingredient having known functions, to provide a composition having the additive effect of each of the known functions is within realm of performance of ordinary skill artisan. In re Castner, 186 USPQ 213 (217). The use of conventional materials to perform their known functions in a conventional process is obvious. In re Raner, 134 USPQ 343 (CCPA 1962).

### ***Response to Arguments***

Applicant's arguments filed January 5, 2004 and previous declaration have been fully considered but they are not persuasive.

Applicants' argument as set forth in the items 4-5 and 9 of the instant declaration is noted. But, applicants' argument is found inconsistent with the scope of the claims because essential element should be recited in independent claims. Instant independent claims 1, 6, and 11 have not recited a positive lower limit of P. The instant specification does not support the claimed P content is critical. It has been held that features which are merely "preferred" are not critical. In re Goffe, 191 USPQ 429 (CCPA 1976). The property or result relied upon must be disclosed in the specification or flow naturally from the teaching of the specification. In re Slocombe, 184 USPQ 740, 743 and In re Davies and Hopkins, 177 USPQ 381 (CCPA 1973). Mere argument or conclusory statements in the specification is not sufficient. In re Geisler (CA FC) 43 USPQ2d 1362 (7/7/1997).

The instant Figures 9, 10A, and 10B fail to show the claimed P content is critical because comparison must be done under identical condition except for the novel

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features of the invention. In re Brown, 173 USPQ 685 and In re Chapman, 148 USPQ 711. The showing of unexpected results must be occurred over the entire claimed range. In re Clemens, 622 F.2d 1029, 206 USPQ 289, 296 (CCPA 1980). The scope of the showing must be commensurate with the scope of the claims. In re Tiffin, 448 F.2d 791, 792 (Fed. Cir. 1971), In re Coleman, 205 USPQ 1172, In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 778 (Fed. Cir. 1983), and In re Greenfield, 197 USPQ 227.

Applicants argue that the wording "present" requires P in the instant claims. The wording "present" adds nothing to the instant transitional expression "comprising". Furthermore, said wording is followed by "no more than 0.01%" which includes zero (see instant claim 1 and In re Mochel, 176 USPQ 194, 194). Therefore, applicants' argument is found inconsistent with the claim limitation.

Applicants' argument as set forth in paragraph bridging pages 5-6 of instant remarks is noted. First the claimed Young's Modulus range is new matter. Second, arguendo that the claimed Young's Modulus range is supported by instant Figure 7, but according to the instant Figure 7, that conventional solders have a Young's Modulus range of about 4959 – 11437 MPa, which overlaps the instant claimed range no more than about 9512 MPa.

## **Conclusion**

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the

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rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been met by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121.

#### Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (571) 272-1241. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (571)-272-1244.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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ART UNIT 1742

S. Ip  
June 14, 2004